

have been cancelled without prejudice or disclaimer to the subject matter contained therein. Support for the amendments may be found in the "Detailed Description of the Invention." Applicants respectfully request reconsideration of the present application in view of the following remarks.

#### I. Claim Objection

Applicants submit that the amendment to claim 24 renders moot the objection noted in the Office Action.

#### II. Rejections under 35 U.S.C. §112

Claim 21 was rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants submit that the amendment to the specification at page 7, line 22, to specifically incorporate into the Detailed Description the subject matter which is disclosed and claimed in claim 21 renders this §112 rejection moot. This amendment is fully supported by the specification as originally filed and does not constitute new matter. Moreover, applicants submit that an artisan of skill in the art, upon reading the present specification, would clearly recognize that water-vapor-permeable polyesters would constitute suitable hydrophilic materials for use in the claimed invention.

Claim 23 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully submit that the amendments to the claims render moot this §112 rejection.

#### III. The Claims Are Neither Disclosed Nor Suggested by the Cited References

Claims 1-20, 22 and 24-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Blauer et al. (U.S. 5,626,949) in view of Henn et al. (U.S. 5,026,591). Applicants respectfully traverse this rejection.

The Courts have repeatedly held that obviousness under 35 U.S.C. §103 cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994). It is impermissible to use hindsight reconstruction to pick and

choose among isolated disclosures in the prior art to deprecate the claimed invention. *Id.* The §103 rejections raised in the Office Action rely on hindsight reconstruction in the present application to form combinations of art to render applicants' invention obvious, and the Patent Office has also combined references which do not therein provide any suggestion or motivation that the references be combined.

Blauer teaches the application of a high-tensile-strength stratum to a fabric which thereby "provides the shell with dimensional stability, prevents seam slippage and unraveling, ensures the breathability of the shell and maintains shell fabric appearance" (Col 3, lines 56-59). Contrary to the statements in the Office Action, Blauer does not teach improved abrasion resistance. As "dimensional stability" is not defined, its normal meaning as a term in the art must be inferred, i.e. resistance to shrinkage, stretching, contraction or expansion. To one skilled in the art, abrasion resistance is not a parameter that is by any means implied by "dimensional stability". Blauer does teach "external durability"; however, this is achieved by selection of the woven synthetic fabric of the shell and has no relation to the effect of the printed stratum.

The two-layer construction of Henn et al. consists of a monolithic or continuous layer of water-vapour-permeable hydrophilic polymer on a microporous scaffold, bonded to a fabric substrate. Applicants contend that it would not be obvious to one skilled in the art to use an approach that is intended to impart "dimensional stability" to a fabric to impart abrasion resistance to a continuous polymeric layer. The mechanism by which a fabric loses its dimensional stability or unravels is totally different from the mechanism by which the integrity of a polymeric layer is degraded by abrasion.

It is acknowledged in the Office Action that Blauer does not specify exact pattern dimensions, shapes, dimensions and spacing of dots etc., but it is asserted that the use of different designs does not significantly modify the physical properties improved by the discontinuous polymeric layer. Applicants disagree and believe that these statements are highly significant and lend weight to the contention that the problem addressed by Blauer and the problem addressed by applicants' invention are unrelated. It appears that Blauer's solution lies in providing some degree of adhesive bonding between the fibres of the yarn of the fabric construction, as demonstrated by the requirement for coverage of from 10 to 90% of the fabric (e.g., Col 3, lines 60-61). Therefore,

size, shape and distribution of the stratum appear to be irrelevant, provided that there is sufficient ratio of adhesive content to fibre content.

In contrast to Blauer et al., the problem solved by applicants' invention, i.e. poor abrasion resistance of water-resistant, water-vapour-permeable membranes, necessitates specific stratum shapes (dots), dimensions and spacing, as defined and claimed by applicants. Indeed, certain stratum shapes are not preferred (see, e.g., page 11, lines 3-6).

It is stated in the Office Action that "It would have been a matter of design choice to change dimensions...since the applicant has not disclosed that the inner layer dot pattern solves any stated problem or is for any particular purpose."

Applicants respectfully draw the Examiner's attention to page 1, lines 8-28, and page 4, lines 2-4, 10-12, and 23-27, of applicants' specification. The problem to be solved (poor abrasion resistance of water-resistant, water-vapour-permeable membranes) and the purpose of the dot pattern ("a plurality of abrasion-resisting polymeric dots...which dots resist abrasion of the flexible substrate") are clearly defined, applicants believe, in not only these sections of text, but also throughout the specification.

It is also noted in the Office Action that whereas Blauer does not teach the elastic modulus of the dot forming polyurethane, Blauer does disclose that a harder and stronger urethane can be used that is more durable and will not wash off. The Action further states that an elastic modulus would be an inherent result of this type of urethane.

While applicants are somewhat confused by the latter statement, applicants agree that a harder and stronger urethane would in general have a higher elastic modulus. It is not obvious, however, what Blauer means by harder or stronger since neither the strength nor the hardness of the Blauer formulation are disclosed in quantitative form. This lack of teaching is further compounded by the fact that the formulation of the stratum polymer as taught in Blauer has such wide margins of composition that to one skilled in the art it would suggest that the elastic modulus of the stratum polymer is of little importance. This is in contrast to applicants' specification, in which a minimum value of elastic modulus is specified as found to be necessary for the utility of the invention.

It is stated in the Office Action that abrasion resistance, water resistance, and water vapour permeability would be inherent properties of the fabric and substrate composition as taught in Henn et al., and that these properties would

be unaffected by the polymeric dot layer. Applicants agree with this inference only in the case of water resistance. Applicants respectfully draw the Examiners attention to pages 17-20 of applicants' specification in which the considerable effect of the polymeric dots on water-vapour permeability and abrasion-resistance is demonstrated.

The Examiner states that the claim to a garment is only a recitation of intended use as no garment structure is set forth. Applicants respectfully traverse this rejection. Specifically, applicants submit that the term "garment" in the present specification broadly connotes any structure of clothing which would be recognized by an artisan of skill in the art to be worn by an individual. Examples of such garments are found at page 4, lines 14-15 ("hats gloves, shoes") and page 5, lines 11-14 ("...dots, when constituting the innermost lining surface of a garment, will present a more comfortable feel to the wearer and avoid snagging of the skin or any inner clothing worn by the wearer.") Thus, applicants submit that the recitation of a garment is supported and described in the specification and does bear patentable weight. Accordingly, applicants request that this position be withdrawn.

Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Blauer et al. in view of Henn et al. as applied to claims 1-20 and 26 above, and in further view of Gore et al. (U.S. No. 4,194,041).

Applicants submit that there would be no motivation or suggestion in any of the cited references for one skilled in the art to combine the teaching in these specifications. Applying the "stratum" as taught by Blauer et al. to the polyurethane layer of the Henn et al. teaching would not add "dimensional stability" to the outer shell fabric, nor prevent it from unraveling as Blauer et al. teaches. Applying the waterproof, breathable fabric of Henn et al. over the stratum of Blauer, even if it were possible to do so, would give a product that is far removed from applicants' invention. Moreover, as noted above, no motivation or suggestion exists for this combination.

Claims 30-57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Henn et al. in view of Blauer et al. Applicants submit that the cancellation of these claims without prejudice or disclaimer to the subject matter contained therein renders the rejection moot.

IV. Conclusion

For the foregoing reasons, the present invention as defined by claims 1-29 is neither taught nor suggested by any of the references of record. Accordingly, applicants respectfully submit that these claims are now in form for allowance. If further questions remain, applicants request that the Examiner telephone applicants' undersigned representative before issuing a further Office Action.

Respectfully submitted,

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